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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,497	10/15/2003	Thomas J. Bachinski	12929.1072USC1	9051

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Robert A. Kalinsky
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER

BASICHAS, ALFRED

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,497

Applicant(s)

BACHINSKI ET AL.

Examiner

Alfred Basichas

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28, 30-37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-28, 30-37 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 24-28, 31-37, and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S.

Patent No. 6,672,860. Although the conflicting claims are not identical, they are not patentably distinct from each other because the overall scope of the claimed invention is practically the same.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3749

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 24, 25, 27, 31-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (IE 80484B3) in view of Ellis (3,851,242), Philipp (6,466,036), or Denen (6,838,887). McCarthy discloses substantially all of the claimed limitations including, among other things, a fireplace with a proximity warning system having an electronic fire guard sensor (1) is typically located on or underneath the mantelpiece of a fireplace (2) or may be located in an alternative position as long as this does not prohibit its operation and the area coverage of the device. The sensor comprises a local oscillator/transmitter arrangement when generating and transmitting a signal setting up a field (3) around the sensor and the fireplace and is preferably a microwave signal although it could be an infrared signal. Once the sensor is operating and the field is established, any motion caused for instance by a person or object moving in the protected zone and disturbing the field, causes an alarm to be activated, i.e. an audio and/or visual alarm. Nevertheless, McCarthy is silent as to the use of a capacitance module and its relationship with the alarm module. Ellis, Philipp, and

Denen all teach measuring capacitance in a proximity detector and that such an arrangement is beneficial in that it is more efficient and avoids errors (Ellis), "This circuit arrangement is more compatible with available integrated circuit design and manufacturing practices than is prior art pulse circuitry, which commonly had one side of at least one switching element floating. These improved arrangements thereby provide superior performance at a lower manufacturing cost" (Philipp), and "A circuit made of a few parts tends to help with reliability, cost and ease of manufacture. Another desirable characteristic for electronic circuits of this type is that they have a high degree of noise immunity, i.e., they work well in an environment where there may be electromagnetic noise and interference. Consequently a more noise-immune circuit will perform better and it will have acceptable performance in more areas of application" (Denen). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the circuitry of Ellis, Philipp, or Denen into the invention disclosed by McCarthy, because it is within the general skill of one of ordinary skill in the art to select a known structure on the basis of its suitability for the intended use.

6. Claims 26, 28, 35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (IE 80484B3) in view of Ellis (3,851,242), Philipp (6,466,036), or Denen (6,838,887). The combination discloses substantially all of the claimed limitations as discussed above, but does not specifically disclose a plurality of modules, varying the size of the zone, or that the given temperature be an unsafe temperature.

As regards the plurality of modules, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a plurality of modules into the invention disclosed by the above combination, since it has been held that to provide duplicate parts for multiplied effect is not the type of innovation for which a patent is granted. *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11.

As regards varying the size of the zone, Official Notice is given that a detection system having a detection zone and means for varying the zone is old and well known in the art to allow the user a choice in the size of the area for which detection is necessary or desired. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated means for varying the zone into the invention disclosed by the above combination, so as to provide for a desired detection area size.

As regards the requirement that the given temperature be an unsafe temperature, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the claimed temperature into the invention disclosed by the above combination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable values involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It should be further noted that the entire premise behind the instant invention is to warn of unsafe temperatures for a fireplace. Simply stated, the whole point of any fireplace warning system is to avoid unsafe temperatures, be it for personal safety or structural integrity of the premises. As the prior art already teaches the claimed invention for a

given temperature, it is clearly obvious, if not wholly inherent that the temperature at which the alarm engages be one that would be that which is desirous to avoid, at least for any extended period.

Response to Arguments

7. Applicant's arguments with respect to the claim have been considered but are moot in view of the new grounds of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 571 272 4871. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center telephone number is 571 272 3700.

November 7, 2005


Alfred Basichas
Primary Examiner